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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,273	11/30/2001	Michael Kende	92654-008	2603

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EXAMINER

APPLE, KIRSTEN SACHWITZ

ART UNIT	PAPER NUMBER
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3693

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,273

Applicant(s)

KENDE ET AL.

Examiner

Kirsten S. Apple

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(a).

Status

- 1) ☐ Responsive to communication(s) filed on 30 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/18/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>no IDS</u> | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

This action is in response to the application filed on 11/30/2001.

Priority

Acknowledgment is made of applicant's claim for prior priority date of U.S. Provisional Patent Application 60/250,834 filed on 12/01/2000.

Claim Objections

Claim 1-24 are objected to because of the following informalities: misspellings. Appropriate correction is required.

In particular claim 1 & 14 are indefinite and the examiner did not understand:

"rate plain"

The examiner assumed it was a misspelling. For the purposes of this review the examiner will interpret the claim to be:

"rate plan"

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Since the body of the claims recites software & database without any physical structural limitations it is unclaimed to the examiner what to be considered as claimed.

Claim Rejections - 35 USC § 101

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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In particular, at least the independent claims recite a computer program.

Although the claim beginning with the term "system" everything that follows refers to software. The examiner is interpreting the claim as describing a "computer program."

The MPEP section 2106 (page 2100-13 of MPEP version 8) clearly outlines "Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

Corrective action to Claims 1-13 is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Roberts (US Patent 6,885,997 B1).

Re claim 1 & 14: Roberts discloses:

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A method & system for analyzing service provider rate plan information, comprising:

A user module for accessing user information (see , Figure 5, item 402)

A service provider data base for storing service provider information wherein service provider information comprises rate plan information associated with one or more service providers; and (see , Figure 5, item 410)

An analysis engine module for analyzing user information and service provider information to generate one or more savings suggestions base on rate information and at least one other user preference. (see , Figure 5, item 416)

Re claim 2 & 15: Roberts discloses:

User information comprises user entered profile information (see , Figure 5, item 402)

Re claim 3 & 16: Roberts discloses:

User information comprises user prior usage information (see , Figure 5, item 402)

Re claim 4 & 17: Roberts discloses:

User information comprises user entered profile information and prior usage information (see , Figure 5, item 402)

Re claim 5 & 18: Roberts discloses:

A savings module/step for providing personalized savings information where in personalized savings information is generated by the analysis engine module (see , Figure 7, item 64)

Re claim 6 & 19: Roberts discloses:

Savings information comprises static savings information (see , Figure 7, item 64)

Re claim 7 & 20: Roberts discloses:

Savings information comprises proactive savings information (see , Figure 7, item 64)

Re claim 8 & 21: Roberts discloses:

External data module/step further analyses user independent data in generating one or more preferred savings suggestions (see , Figure 6, item 506)

Re claim 9 & 22: Roberts discloses:

A switching module/step for facilitating switching the user to the one or more preferred savings suggestions wherein the one or more preferred savings suggestions comprises a new rate plan (see , Figure 8, item 602)

Re claim 10 & 23: Roberts discloses:

Switching module/step for facilitating switching the user to the one ore more preferred savings suggestions wherein the one or more preferred savings suggestions comprises a new service provider (see , Figure 7, item 64)

Re claim 11 & 24: Roberts discloses:

A demand aggregation module/step for aggregating one or more users who are willing to transfer to an identified service provider (see , Figure 8, item 604, it is inherent that if you are tracking multiple orders you would aggregate them if same service provider identified)

Re claim 12 & 25: Roberts discloses:

A demand aggregation module/step for aggregating one or more users who are willing to transfer to an identified rate plan (see , Figure 8, item 604, it is inherent that if you are tracking multiple orders you would aggregate them if same rate plan identified)

Re claim 13 & 26: Roberts discloses:

A delivery module (see , Figure 8, item 606)

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on 571.272.6799. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa


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